



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,626	07/25/2001	Ronald S. Karpf	K1625.0002/P002-A	5027

24998 7590 06/14/2005

DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP
2101 L Street, NW
Washington, DC 20037

EXAMINER

HANNE, SARA M

ART UNIT PAPER NUMBER

2179

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/911,626

Applicant(s)

KARPF, RONALD S.

Examiner

Sara M Hanne

Art Unit

2179

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 5/2/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the RCE received on 5/2/05. Claims 10-29 are pending in the application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 10-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically the amendments to Claims 10, 17 and 23: "response is not predetermined" from Claims 10 and 17 and "the input location received by the respondent is not determined by the system in advance." from Claim 23. Any negative limitation or exclusionary proviso must have basis in the original disclosure. The mere absence of a positive recitation is not basis for exclusion. MPEP 2173.05(i).

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 10-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A method of conducting an interview as presented in Claim 1 is non-statutory as not being tangible. The claims should be amended to include a tangible embodiment or implementation.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 10-12, and 17-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Boyer et al., US Patent 6268849, hereinafter Boyer.

As in Claim 10, Boyer teaches conducting an interview of a respondent, the method comprising presenting an interview question to a respondent ("Select State of Interest", Figure 3), presenting a map (Figure 3, ref. 302), and receiving an indication of a location-input from the respondent in response to the presented question (Col. 7, line 7 et seq.), wherein the received response is not predetermined by the interview system (the system is unaware of what input the user will make).

As in Claim 11, Boyer teaches the step of receiving an input point on the map when it is input by the user (Col. 7, line 9).

As in Claim 12, Boyer teaches the step of receiving being an input region on the map when it is input by the user (Col. 7, line 9 and Col. 7, lines 15 et seq.).

As in Claim 17, Boyer teaches an article of manufacture with a machine-readable storage medium with machine-executable control program steps including issuing one of a series of questions (Fig. 3-4), in response to a given question of the series of questions receiving a location response (Col. 7, lines 5-16) , wherein the received response is not predetermined by the interview system (the system is unaware of what input the user will make), determining the validity of the location response received, if the location response is invalid, reissuing the given question and repeating the process (Col. 7, lines 17-20).

As in Claim 18, Boyer teaches providing a map display used to facilitate the graphical input response to the given question (Fig. 3 and 4).

As in Claim 19, Boyer teaches that if the location response is determined to be valid, a subsequent question is asked, location response received, and validity tested as in Claim 17 (Col. 7, line 5 et seq., the system does not move onto Figure 4 until a valid region, a state, has been selected).

As in Claim 20, Boyer teaches a location response providing an answer that indicates an approximate location (region, Fig. 4 and corresponding text).

As in Claim 21, Boyer teaches a textual input of a location response in the form of an alphanumeric address (numeric Fig. 2, ref. 244, alpha Col. 7, lines 26 et seq.).

As in Claim 22, Boyer teaches a textual and graphical input of an initial location response (Col. 7, line 24 et seq.).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boyer et al., US Patent 6268849, hereinafter Boyer, and further in view of Mullet et al., US Patent 5638523.

Boyer teaches presenting an interview question to a respondent, presenting a map, and receiving an indication of a location-input from the respondent in response to the presented question. While Boyer teaches question presentation and map input in response, they fail to show the receiving, as the input region, a proximate area having a circular shape surrounding a point on the map presented as recited in Claim 13. In the same field of the invention, Mullet et al. teaches an interactive map similar to that of Boyer. In addition, Mullet et al. further teaches receiving, as the input region, a proximate area having a circular shape surrounding a point on the map presented (Fig. 3A, Ref. 15 and Col. 4, lines 46-50). It would have been obvious to one of ordinary skill in the art, having the teachings of Boyer and Mullet et al. before him at the time the invention was made, to modify the presentation of a question and map input response in reply to the question taught by Boyer to include the circular selection of a input region of Mullet et al., in order to obtain an approximate input through circular selection. One

would have been motivated to make such a combination because a way to select a region of area on a map within a certain radius of a particular point would have been obtained, as taught by Mullet et al.

10. Claims 14-16, 23-25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyer et al., US Patent 6268849, hereinafter Boyer, and further in view of William Drummond's, "Address Matching, GIS Technology for Mapping Human Activity Patterns" in the Journal of the American Planning Association, hereinafter referred to as Drummond.

As in Claim 14, Boyer teaches presenting an interview question to a respondent, presenting a map, and receiving an indication of a location-input from the respondent in response to the presented question and validating the location as seen in Claims 10 and 17 *supra*. While Boyer teaches map input in response to a presented question, they fail to show geocoding the location input as recited in the claims. In the same field of the invention, Drummond teaches a map input system similar to that of Boyer. In addition, Drummond teaches the step of geocoding the location-input received ("Basics of Address Matching Page 2). It would have been obvious to one of ordinary skill in the art, having the teachings of Boyer and Drummond before him at the time the invention was made, to modify the presentation or question information and map input response taught by Boyer to include the alphanumeric textual input location information of Drummond, in order to obtain a textual input for the location information to be input to the system. One would have been motivated to make such a combination because a

standardized location matching system would have been obtained, as taught by Drummond.

As in Claim 15, Boyer teaches presenting an interview question to a respondent, presenting a map, and receiving an indication of a location-input from the respondent in response to the presented question and validating the location as seen in Claims 10 and 17 *supra*. While Boyer teaches map input in response to a presented question, they fail to show a latitude/longitude determination as recited in the claims. In the same field of the invention, Drummond teaches a map input system similar to that of Boyer. In addition, Drummond further teaches determining latitude and longitude of the location-input (latitude and longitude are determined during matching, page 2) as in Claim 15. It would have been obvious to one of ordinary skill in the art, having the teachings of Boyer and Drummond before him at the time the invention was made, to modify the presentation or question information and map input response taught by Boyer to include the latitude/longitude determination of Drummond, in order to obtain a defined location of an area input by the user. One would have been motivated to make such a combination because a universally recognized geocoding system would have been obtained, as taught by Drummond.

As in Claim 16, Boyer teaches a proximate area based on the indication of the location-input received (see Claim 20 rejected *supra*)

As in Claim 23, Boyer teaches a system comprising a display of questions to a respondent, a device for graphical input by a respondent of an input location entered through graphical indications on a map display with an input device providing for both

textual and graphical input by a respondent of an input location in response to a location question, wherein the textual input is entered through a textbox (ref. 244) and the graphical input is entered through graphical indications on the map display (Fig. 3-4 with corresponding text) and wherein the input location received by the respondent is not determined by the system in advance (the system is unaware of what input the user will make). While Boyer teaches map and textual input in response to a presented question, they fail to show a geocoding processor as recited in the claims. In the same field of the invention, Drummond teaches a map input system with an alphanumeric address and a textual and graphical input of an initial location response (Page 4, paragraph 4) similar to that of Boyer. In addition, Drummond further teaches a geocoding processor, wherein the processor is programmed to perform geocoding on the input location provided by the input device (Microcomputer based, page 8). It would have been obvious to one of ordinary skill in the art, having the teachings of Boyer and Drummond before him at the time the invention was made, to modify the presentation or question information and map input response taught by Boyer to include the geocoding processor of Drummond, in order to obtain geocoded input for the location information input from selecting a location on a map to the system. One would have been motivated to make such a combination because a standardized location matching system would have been obtained, as taught by Drummond.

As in Claim 24, While Boyer teaches map and textual input in response to a presented question, they fail to show a geocoding processor as recited in the claims. In the same field of the invention, Drummond teaches a map input system with an

alphanumeric address and a textual and graphical input of an initial location response (Page 4, paragraph 4) similar to that of Boyer. In addition, Drummond teaches the geocoding processor performs geocoding on the input location immediately after entry by said input device (Page 2, "Basics of Address Matching"). It would have been obvious to one of ordinary skill in the art, having the teachings of Boyer and Drummond before him at the time the invention was made, to modify the presentation or question information and map input response taught by Boyer to include the geocoding on the input location immediately after entry by said input device of Drummond, in order to obtain a immediate geocoding of location information to be input through a map to the system. One would have been motivated to make such a combination because a standardized location matching system would have been obtained, as taught by Drummond.

As in Claim 25, Boyer teaches the input device identifies an exact location on the map provided on said map display when the respondent inputs a location (Page 3, Par. 2).

As in Claim 28, While Boyer teaches map and textual input in response to a presented question, they fail to show the geocoding processor programmed to provide a unique point specification of a place representative of an input location as recited in the claims. In the same field of the invention, Drummond teaches a map input system with an alphanumeric address and a textual and graphical input of an initial location response (Page 4, paragraph 4) similar to that of Boyer. In addition, Drummond teaches the geocoding processor programmed to provide a unique point specification of

a place representative of an input location (Page 2, "Basics of Address Matching"). It would have been obvious to one of ordinary skill in the art, having the teachings of Boyer and Drummond before him at the time the invention was made, to modify the presentation or question information and map input response taught by Boyer to include the unique point input specification of Drummond, in order to obtain a unique point specified by the user selecting a location on a map that is geocoded by the system. One would have been motivated to make such a combination because a standardized location matching system would have been obtained, as taught by Drummond.

11. Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyer et al., US Patent 6268849, hereinafter Boyer, and William Drummond's, "Address Matching; GIS Technology for Mapping Human Activity Patterns" in the Journal of the American Planning Association, hereinafter referred to as Drummond, and further in view of Bailey, US Patent 6604083.

As in Claim 26, Boyer and Drummond teach presenting an interview question to a respondent, presenting a map, and receiving an indication of a location-input from the respondent in response to the presented question textually or graphically such that the selected location is geocoded (See Claim 23 rejection *supra*). While Boyer and Drummond teaches question presentation and map or text input in response, they fail to show the highlighting the input region on the map display that identifies an approximate location as the input location as recited in Claim 26. In the same field of the invention, Bailey teaches an interactive location geocoding system similar to that of Boyer and

Art Unit: 2179

Drummond. In addition, Bailey further teaches highlighting, as the input region, a proximate area on the map presented (Col. 4, line 56 et seq.). It would have been obvious to one of ordinary skill in the art, having the teachings of Boyer and Drummond and Bailey before him at the time the invention was made, to modify the presentation of a question and map or textual input response in reply to the question taught by Boyer and Drummond to include the highlighting selection of a input region of Bailey, in order to obtain an approximate input location device through highlighting. One would have been motivated to make such a combination because a way to visually select a region of area on a map would have been obtained, as taught by Bailey.

As in Claim 27, While Boyer teaches map and textual input in response to a presented question, they fail to show a census tract input as recited in the claims. In the same field of the invention, Drummond teaches a map input system with an alphanumeric address and a textual and graphical input of an initial location response (Page 4, paragraph 4) similar to that of Boyer. In addition, Drummond teaches the graphical input to be a census tract (Col. 6, lines 28-45, street segments). It would have been obvious to one of ordinary skill in the art, having the teachings of Boyer and Drummond before him at the time the invention was made, to modify the presentation or question information and map input response taught by Boyer to include the input to be a census tract of Drummond, in order to obtain census tract graphical input of location information. One would have been motivated to make such a combination because a standardized location matching system would have been obtained, as taught by Drummond.

Response to Arguments

Applicant's arguments with respect to claims 10-29 have been considered but are moot in view of the new ground(s) of rejection. The examiner stands that Wood teaches all of the limitations of Claims 10-12, 14 and 17-19 as currently presented, however the examiner feels that newly cited references of Boyer and Bailey, more explicitly illustrate the amended claims.

Conclusion

The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach similar mapping input systems and geocoding methods.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara M Hanne whose telephone number is (571) 272-4135. The examiner can normally be reached on M-F 7:30am-4:00pm, off on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

smh


BA HUYNH
PRIMARY EXAMINER